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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/747,622	12/30/2003	Frederick A. Enko	06181-930001	2901
26171	7590	07/12/2005	EXAMINER	
FISH & RICHARDSON P.C. P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			JOHNSON, JERROLD D	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	10/747,622	ENKO, FREDERICK A.	
	Examiner	Art Unit	
	Jerrold Johnson	3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 16-26 is/are pending in the application.
- 4a) Of the above claim(s) 8-10, 16 and 20-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 11-13 and 17-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-26 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Newly submitted claims 16 and 20-26 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Claims 16 and 20-22 are drawn to a non-elected patentably distinct species of a puzzle storage device having a detached inflatable tube. Accordingly, restriction is proper and claims 16 and 20-22 are withdrawn from consideration. This non-elected species is also not shown in the drawings.

Claims 23-26 are drawn to a combination where the combination does not contain all of the limitations of the sub-combination as set forth in claim 1. Specifically, claim 23 does not include the limitation "while the inflatable tube is inflated" as set forth in claim 1. Accordingly, restriction is proper and claims 23-26 are withdrawn from consideration.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits.

See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 102

1. Claims 1,2,12,13 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Sullivan US 5,966,757.

With respect to claim 1, Sullivan 1discloses a device inherently capable of being used as a puzzle storage device comprising:

a puzzle assembly mat inherently capable of receiving one or more puzzle pieces; and

an inflatable tube around which a puzzle assembly mat and the one or more puzzle pieces may be rolled while the inflatable tube is inflated.

Please note extrinsic evidence 5,375,707, which shows how a puzzle can be rolled around a tubular element for storage.

With respect to applicant's arguments, it is first noted that claim 1 recites "for receiving one or more puzzle pieces" it does not set forth a combination where a puzzle is in fact claimed on the mat. Alternatively, only intended use is set forth. Additionally, the claim does not positively set forth the combination of a puzzle assembly mat, an inflatable tube, and a puzzle, where the mat is rolled while the inflatable tube is inflated. Instead, the claim recites that the mat *may be rolled* while the inflatable tube is inflated.

Applicants arguments are based on whether or not one *would* use the invention of Sullivan as a puzzle storage device, when the issue with respect to intended use is not whether or not one *would* use the device in this way, but if *could* use the device in the manner described in the intended use. Or in other words, is the device inherently capable of this intended use. In the present situation, although Sullivan does not expressly disclose this intended use, he does disclose a device which clearly has this

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inherent capability. Extrinsic evidence 5,375,707, not relied upon in the rejection, evidences that rolling a puzzle disposed on a mat around a tubular element is something that can and has been done. This extrinsic evidence supports the factual conclusion that Sullivan could also be used in this manner. With respect to the limitation "may be rolled while the inflatable tube is inflated" the applicant has presented arguments that one *would* not roll the system of Sullivan while inflated are not persuasive. Again, the issue is not whether one would roll Sullivan when inflated, but whether or not one could. Clearly, this is a function which is well within the inherently capabilities of Sullivan.

Intended use is discussed in the MPEP in 2111.02. Note the end of this section where it recites from *In re Schreiber*, "If a prior art structure is capable of performing the intended use as recited in the preamble, then it meets the claims." This standard is also used for functional limitations.

With respect to claim 2, the inflatable tube is attached to an end of the puzzle assembly mat.

With respect to claim 12, the puzzle assembly mat comprises a rough surface (the towel surface).

With respect to claim 13, the puzzle assembly mat comprises a plastic or vinyl sheet and the rough surface comprises a flocked surface (the towel).

With respect to claim 18, Sullivan discloses a single inflation chamber.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sullivan 5,966,757 in view of Roberts US 6,131,219.

Sullivan discloses the claimed invention with the exception of multiple inflation chambers within the inflatable tube (his pillow).

Roberts teaches the use of multiple chambers in a pillow so as to provide specific support characteristics to the pillow.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the inflatable tube of Sullivan with the teachings of Roberts so as to provide a better supporting pillow.

3. Claims 4-7, 11 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sullivan 5,966,757 in view of Sullivan US 6,182,309.

Sullivan 5,966,757 discloses the claimed invention with the exception of a mechanism to secure the puzzle assembly mat around the inflatable tube.

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Sullivan US 6,182,309 teaches the use of straps comprising elastic loops for securing a mat around a tube. The benefits of the straps are greater ease of portability of the towel/pillow device.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the mat and inflatable tube of Sullivan 5,966,757 with the teachings of Sullivan 5,966,757 so as to provide a more easily transported device.

With specific respect to claim 7, hook and loop fasteners are considered an art recognized equivalent to the straps and elastic loops previously rejected, and are rejected for the reasons stated above.

With specific respect to claim 17, making the straps either detached or attached to the mat would not be patentable significant, as making elements of this type integral or separable has been held to be obvious to one of ordinary skill in the art. Note MPEP 2144.04 V. sections B. and C.

3. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sullivan 5,966,757 in view of Gregg US Des 392,146.

Sullivan does not disclose the inflatable tube (pillow) having a length that equals the width of the puzzle assembly mat.

Gregg discloses a pillow which extends the width of the mat.

It would have been obvious to one of ordinary skill in the art to have modified the system of Sullivan with the teaching of Gregg of a pillow which extends the width of the

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mat, so as to provide a comfortable surface to rest over a longer distance, an increase the comfort provided by the device.

It is noted that extending the pillow of Sullivan the entire width of the mat would necessarily result in the outer pockets needing to be moved to accommodate this width. No functionality of the system of Sullivan would be lost from this modification, however, and Sullivan, in col. 4, lines 24-26 describes "*one or more pockets*" (italics added).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerrold Johnson whose telephone number is 571-272-7141. The examiner can normally be reached on 9:30 to 6:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JDJ



Mickey Yu
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